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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,283	01/25/2005	Ytsen Wielstra	NL 020703	1507

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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02/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,283	<b>Applicant(s)</b> WIELSTRA ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/13/07 Amendment.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>English translation of DE 299 23 595</u> . |



### **DETAILED ACTION**

1. The Applicants' amendment filed November 13, 2007 is acknowledged.  
Claims 1-5 are amended. Claims 6-13 are added. Now, Claims 1-13 are pending.
2. Claim rejection(s) under 35 USC 101 in the previous Office Action (Paper No. 081807) is/are removed.
3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 081807) is/are removed.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).
5. Applicant is advised that should Claims 6-7 be found allowable, Claims 11-12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

6. Claims 1-2, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by DE595 (DE 299 23 595).

DE595 discloses a process of coating a utensil with a composition comprising a fluorinated silane by a sol-gel process. (claims) The English translation is provided for Applicants' reference.

For Applicants' argument under subtitle "35 U.S.C. §§ 102 & 103", Examiner takes Official Notice that conventionally a fluorinated silane used in sol-gel process indeed refers to a hydrolyzable silane containing a fluorine-bearing non-hydrolyzable group.

7. Claims 1-3, 5 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP989 (JP 05-116989).

JP989 discloses a method of coating a utensil such as eye glasses, plastic lenses, etc. with a composition comprising fluorinated alkyl trialkoxysilanes, etc. ([0003] and [0005])

For Applicants' argument under subtitle "35 U.S.C. §§ 102 & 103", Examiner disagrees because JP989's fluorinated alkyl group is non-hydrolyzable.

8. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Jonschker (WO 99/50477).

The following column and line numbers are based on Jonschker's US equivalent (US 6 403 164).

Jonschker discloses a method of coating utensils such as shavers, etc. with a composition comprising at least one hydrolysable silicon compound of formula (I) that can contain fluorinated alkyl substituents such as **tridecafluoro-1,1,2,2-tetrahydrooctyltriethoxysilane**. (col. 1, line 50 to col. 2, line 67, col. 5, lines 21-40 and col. 9, line 57 to col. 10, line 9)

### ***Claim Rejections - 35 USC § 103***

9. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE595.

DE595 discloses a coated utensil, *supra*, which is incorporated herein by reference. DE595 is silent on the silane contains at least one alkoxy group. However, silanes used in a sol-gel process typically contain alkoxy groups as hydrolysable groups because they are readily available commercially. As such, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a fluorinated alkoxy silane in DE595's composition with expected success.

10. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP989.

JP989 discloses a method of coating a utensil, *supra*, which is incorporated herein by reference. JP989 further teaches the use of tridecafluoro-1,1,2,2,-tetrahydrooctyltrimethoxysilane. ([0005]) JP989 is silent on tridecafluoro-1,1,2,2,-tetrahydrooctyltriethoxysilane. However, the aforementioned silanes are homologues. Court held that compounds which are homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH<sub>2</sub>- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are



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unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

February 15, 2008

/Kuo-Liang Peng/  
Primary Examiner, Art Unit 1796